

claim 4, further comprising means for displaying some sentences and a selection indicator adjacent to the selected sentence and wherein said informing means comprises means for displaying an agreement indicator indicating that the similarity determination means detects the agreement of both data.

14. (previously presented) The recording medium according to claim 7, further causing the computer to execute the step of displaying some sentences and a selection indicator adjacent to the selected sentence and wherein said informing step displays an agreement indicator indicating that the similarity determination steps detect the agreement of both data.

#### REMARKS

This Amendment is in response to the Office Action mailed December 17, 2005. The Examiner's comments in that Action have been carefully considered.

A request for an extension of one month has been made, and applicants have authorized that the \$120.00 extension fee be charged to our charge account no. 10-0100.

In this non-final Office Action, the Examiner has rejected all pending claims

1, 3-7 and 9-14 as defining subject matter that is obvious on the basis of the primary patent to Shpiro et al. '671 in view of or when combined with a newly cited secondary reference, Lee et al. '011. In making the rejection, in paragraph 3 of the Office Action, the Examiner suggests that Shpiro et al. essentially teaches everything that is recited in the two pending independent claims 1 and 7, recognizing that Shpiro et al. is primarily concerned with teaching pronunciation. The Examiner concedes that Shpiro et al. does not teach a database for storing a plurality of reference pronunciation data for one sentence in a single language and corresponding to pronunciation fluency levels, for this sentence, and a user operative member for selecting one of the plurality fluency levels. To make up for such deficiency, the Examiner relies on the patent to Lee et al., directing applicant to column 5, lines 11-21, which teaches a system and method for improved learning of foreign language using an indexed database. On page 3 of the Office Action, the Examiner discusses Lee et al. and the teaching at column 5, lines 11-21, as well as at column 5, lines 34-40, which, the Examiner states, teaches a learning database in which vocabulary data is classified by learning level, index table and start index. When the user enters a learning mode execution command

corresponding to the learning level, the Examiner states, the corresponding data from the learning, a database is read. The Examiner concludes that one of ordinary skill in the art at the time the invention was made would have found it obvious that vocabulary data classified by learning levels as taught by Lee et al. could be stored within the database of Shpiro et al., with the motivation being that it would provide a systematic and simple database that provides an effective learning effect.

In rejecting claims 3 and 9 as well as claims 4 and 10, the Examiner suggests that the proposed combination of references teaches a pronunciation database that stores reference pronunciation data of a plurality of pronunciation fluency levels.

For reasons that are more fully discussed below, the Examiner's rejection of the claims is respectfully traversed, and the Examiner is requested to withdraw the rejections.

The Examiner acknowledges that Shpiro et al. (U.S. Patent No. 5,487,691) teaches neither a database for storing a plurality of reference pronunciation data for one sentence in the same language, one that corresponds to a plurality of

pronunciation fluency levels for that sentence, nor a user operative member for selecting one of said plurality of pronunciation fluency levels. This reference merely teaches a reference audio specimen library 120 that stores reference audio specimens for each of a multiplicity of phonemes, words and/or phrases that are typically pre-recorded by each of a plurality of speech models. Even though a plurality of reference audio specimens is prerecorded by each of a plurality of speech models, one speech model, the one most suitable to user, must be selected in step 405 (Fig. 5). This plurality of speech models found in Shpiro et al. does not correspond to the plurality of pronunciation fluency levels taught in the subject application.

The Examiner states that the features that are not taught in Shpiro et al. are well known in the art, as illustrated by the reference to Lee. Lee, however, is not interested in pronunciation, but in vocabulary. This patent merely teaches a learning database configuration that is formed by various levels of vocabulary (higher – high – middle – elementary; column 4, lines 6-8). As shown in this patent's Fig. 2, the arrangement of each piece of data is determined using considerations of priority. This priority is determined by dividing the data into a

number of learning levels such as – as explained above – higher, high, middle, elementary. Lee neither teaches nor suggests a database for storing a plurality of reference pronunciation data of a sentence in one language, one that corresponds to a plurality of pronunciation fluency levels that are possible for the sentence. Lee merely teaches that, once a user has input a learning mode execution command, a microcomputer 4, using the index table and the start index of the learning database 9 (column 5, lines 34-35), recognizes the address for the piece of data that corresponds to the contents for the learning mode set for this user. Thus, this command has nothing to do with the selection of a number of pronunciation fluency levels.

As neither of the references relates to the database and user operative member recited in claim 1, it is respectfully submitted that claims 1 and 7 of the subject application patentably distinguish over both Shpiro et al. and Lee.

In this connection, it is respectfully noted that neither Shpiro nor Lee in any way mention or discuss fluency levels as discussed and claimed in the subject application.

The statutory standard for the ultimate determination of obviousness

provides that a claimed invention is unpatentable if the differences between it and the prior art 'are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.' 35 U.S.C. § 103 (1994). In line with this statutory standard, the case law provides that 'the consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art.' *In re Dow Chem.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988).

Two requirements are contained in this criterion. The first requirement is that a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential evidentiary component of an obviousness holding.' *C.R. Bard, Inc., v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)."

(i) This evidence may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. *See Pro-Mold & Mold Co. v. Great Lakes Plastics, Inc.*,

75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996). However, the suggestion more often comes from the teachings of the pertinent references. *See Om re Roufflet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

(ii) The showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not ‘evidence.’ *See Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617.

The U.S. Patent and Trademark Office cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

The factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. *See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) (‘a showing of suggestion, teaching, or motivation to combine the prior art references is an “essential component of an obviousness holding”’ (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998))); *In re Dembiczak*, 175 F.3d

994, 999 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ('Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.');

*In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined *only* if there is some suggestion or incentive to do so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ('particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed'); *In re Roufflet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ('even when the level of skill in the art is high, the Board must



identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.’); *In re Fritch*, 972, F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination ‘only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references’).

Thus, where the Board has rejected the need for ‘any specific hint or suggestion in a particular reference’ to support the combination of the ... references, omission of a relevant factor required by precedent is both legal error and arbitrary agency action. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002)

Thus, it is clear that to establish a *prima facie* case of obviousness, the U.S. Patent Office must, *inter alia*, show ‘some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead

that individual to combine the relevant teachings of the references.’ *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). *See, also, In re Thrift*, 298 F.3d 1357, 63 USPQ2d 2002 (Fed. Cir. 2002).

There must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor. *Crown Operations International, Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). Anything less is clearly hindsight reconstruction, which has been consistently forbidden by the courts.

Here, the Examiner has simply alleged some broad conclusory statements, without pointing to any objective evidence in the references or elsewhere, that shows it would have been obvious to combine because the motivation to do so was present in the prior art. This is error, and it fails to establish a prima facie showing of obviousness under 35 U.S.C. § 103.

In view of the foregoing, it is respectfully submitted that the prior art, on the record, does not establish a motivation for the proposed combination.

U.S. Patent Application of Kojima  
Serial No.: 09/856,393 – Art Unit: 2654

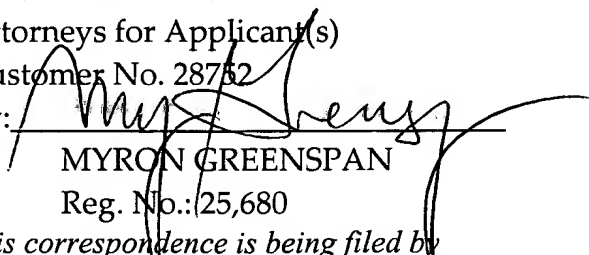
Furthermore, as suggested above, even if the motivation was there to combine the references as proposed by the Examiner, the resulting combinations would still fail to meet the limitations of the rejected claims, particularly as amended herein.

Accordingly, the Examiner is respectfully requested to reconsider the rejections of the claims and withdraw the same.

The application is now believed to be in condition for allowance. Early allowance and issuance is, accordingly, respectfully solicited.

*Applicant hereby petitions that any and all extensions of time of the term necessary to render this response timely be granted. COSTS FOR SUCH EXTENSION(S) AND/OR ANY OTHER FEE DUE WITH THIS FEE DUE WITH THIS PAPER THAT ARE NOT FULLY COVERED BY AN ENCLOSED CHECK MAY BE CHARGED TO DEPOSIT ACCOUNT #10-0100*

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